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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,162	02/13/2001	Kazuma Sato	862.C2116	9463
5514	7590	07/28/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			GART, MATTHEW S	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/781,162	SATO ET AL.
	Examiner Matthew S Gart	Art Unit 3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 May 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 25-34 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 13 February 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>7/23/04</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

RESPONSE TO REQUEST FOR CORRECTED OFFICE ACTION

The Attorney has requested a corrected Office Action and to reset the period of response to commence from the date of the corrected Office Action.

Below is a corrected Office Action per the Interview with Mr. Frank Zear on July 23, 2004.

Claims 1-34 are pending in the instant application. Claims 25-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Election/Restrictions

During a telephone conversation with Leonard Diana on March 22, 2004 a provisional election was made without traverse to prosecute the invention of an information processing apparatus for managing maintenance agreements, claims 1-24.

Paper No. 10, filed April 5, 2004 traverses the provisional election on two grounds. As argued by the Attorney, "first, the Examiner has not met the burden for providing distinctness; and second, the Examiner has not met his burden of establishing reasons for insisting upon restriction."

The Examiner notes, the election requirement made in Paper No. 7 was proper. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, drawn to an information processing apparatus for managing maintenance agreements, classified in class 705, subclass 26.
- II. Claims 25-29, drawn to an information processing apparatus for executing processing related to an expendable used in an image forming apparatus, classified in class 705, subclass 26.
- III. Claims 30-34, drawn to an information processing apparatus comprising a transmission means for transmitting a received malfunction, classified in class 705, subclass 26.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as managing maintenance agreements. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. Furthermore the search required for Group I is not required for Group II.

Since the groups are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, and it is not necessary to show a separate status in the art or separate classification. See MPEP 808.01(a).

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as managing maintenance agreements. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. Furthermore the search required for Group I is not required for Group III.

Since the groups are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, and it is not necessary to show a separate status in the art or separate classification. See MPEP 808.01(a).

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as executing processing related to an expendable used. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. Furthermore the search required for Group II is not required for Group III.

Since the groups are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, and it is not necessary to show a separate status in the art or separate classification. See MPEP 808.01(a).

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 3, filed on 4/5/2001.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujii U.S. Patent No. 5,381,242.

Referring to claim 1. Fujii discloses an information processing apparatus for managing maintenance agreement information corresponding to an identifier for specifying an image forming apparatus, comprising:

- A memory for storing a variety of charge amounts per paper sheet printed and output by the image forming apparatus in accordance with whether the maintenance agreement information includes maintenance information by a serviceman of the image forming apparatus (column 2, line 64 to column 3, line 11); and
- A calculation section for calculating a payable amount on the basis of the charge amount stored in said memory (column 2, line 64 to column 3, line 11).

Referring to claim 2. Fujii further discloses an apparatus wherein said memory stores a first charge amount per printed and output paper sheet including maintenance by the serviceman and a second charge amount without the maintenance, the first charge amount being added with a maintenance cost, unlike the second charge amount (column 8, line 34-54).

Referring to claim 3. Fujii further discloses an apparatus wherein the image forming apparatus and said information processing apparatus are capable of two-way communication through a first network (Figure 1).

Referring to claim 4. Fujii further discloses an apparatus comprising a communication section for generating and transmitting window information for changing the maintenance agreement information stored in said memory (Figure 4a and Figure 4b).

Referring to claim 5. Fujii further discloses an apparatus wherein said communication section receives use situation information of the image forming apparatus and notifies a user of agreement information corresponding to the received use situation information (column 7, lines 48-58).

Referring to claim 6. Fujii further discloses an apparatus wherein said apparatus further comprises a recognition section for recognizing the total number of printed paper sheets of the image forming apparatus in a predetermined period, and said calculation section calculates the payable amount in accordance with the total number of printed paper sheets recognized by said recognition section and the maintenance agreement information corresponding to the image forming apparatus.

Referring to claim 7. Fujii further discloses an information processing method of calculating a charge for use of an image forming apparatus by a user, comprising the steps of:

- Determining contents of a maintenance agreement of each image forming apparatus, which is stored in a memory (column 8, line 34-54); and
- Calculating a payable amount on the basis of a unit price corresponding to the contents of the maintenance agreement and a charge amount stored in the memory (column 8, line 34-54).

Referring to claim 8. Fujii further discloses a method according wherein the memory stores a first charge amount per printed and output paper sheet including maintenance by a serviceman and a second charge amount without the maintenance, the first charge amount being added with a maintenance cost, unlike the second charge amount (column 8, line 34-54).

Referring to claim 9. Fujii further discloses a method comprising the communication step of generating and transmitting window information for changing maintenance agreement information stored in the memory (Figure 4a and Figure 4b).

Referring to claim 10. Fujii further discloses a method wherein the communication step comprises receiving use situation information of the image forming apparatus and notifying the user of agreement information corresponding to the received use situation information (column 7, lines 48-58).

Referring to claim 11. Fujii further discloses a method wherein said method comprises:

- The count step of counting the total number of printed paper sheets of the image forming apparatus in a predetermined period (column 8, line 34-54), and
- The calculation step comprises calculating the payable amount in accordance with the total number of printed paper sheets counted in the count step and the maintenance agreement information corresponding to the image forming apparatus (column 8, line 34-54).

Referring to claims 12-16. Claims 12-16 are rejected under the same rationale as set forth above in claims 1-11.

Referring to claims 17-24. Claims 17-24 are rejected under the same rationale as set forth above in claims 1-11.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cuzzo, U.S. Patent No. 6,052,547, April 18, 2000, discloses a method and apparatus for metering printer/copier usage.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG
April 7, 2004



Jeffrey A. Smith
Primary Examiner